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3622

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,450

Applicant(s)

SUGIYAMA ET AL.

Examiner

James W Myhre

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*RMH*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 8, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 8 recite the limitation "the coupon information" in lines 5-6 and 4 respectively. There is insufficient antecedent basis for this limitation in these claims.

Claim 14 recites the limitation "the prize" in line 12. There is insufficient antecedent basis for this limitation in the claim.

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims (and specification) are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The Examiner has attempted to interpret the specification and claims in light of the assumed inventive goal of the Applicant as ascertained by the Examiner upon review of the application as a whole. The below action is based on this interpretation.

Claim 9 and 10 includes the limitation "to distribute the information of the word of mouth" and "wherein the information of word of mouth includes...". The Examiner is unclear as to the meaning of the phrase "the information of the word of mouth", but will interpret the phrase to mean that the information is being distributed verbally to the user. However, verbal communication with another person is non-patentable as discussed below. In this country under the First Amendment to our Constitution, a person may verbally express any idea, thought, or information freely and without limitation.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 28, 29, and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

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promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is

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statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the

presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 28-30 are three methods for distributing information which includes the steps of storing purchase information, selecting purchase information to be sent to a user based on the classification of the information, distributing the selected purchase information, receiving use log information, storing the use log information, and sending the use log information. All of these steps can be performed manually without the use of technology. For example, the purchase information and use log information may both be stored in a paper database, such as a card file. Once stored, a person may manually select the information to be sent to the user and physically deliver the information to the user using the postal facilities, delivery services, or a courier. The delivered information may be displayed to the user by placing a card or poster containing the information in front of the user. While the claims include the limitations that the information is being received from or sent to various terminals or apparatuses (user terminal apparatus, information distribution apparatus,

sales apparatus, etc.), none of the steps in the claims are actually being performed by these apparatuses. Such incidental recitation of technology in the claims do not place the claimed subject matter within the technological arts. In order to overcome this rejection, the Examiner suggests the Applicant modify the claims to more clearly claim how the technology (i.e. apparatuses) are involved in the method steps. In Claim 28, for example, terminology could be added which clearly shows that the purchase information is being stored in an electronic database, the selection step is being performed by a computer processor (i.e. the information distribution apparatus), the sending and receiving steps are being performed electronically by apparatuses connected to a computer (or electronic) network, etc. Similar changes could be made to the other method claims. The Examiner also notes that while the system and apparatus claims are not being rejected under 35 U.S.C. 101, they too have tenuous connections to the technological arts and could be modified to include a more positive connection to technology in a manner similar to the above suggested changes to the method claims.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 and 16-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Burke (5,848,399).



Claims 1, 2, and 24-33: Henson discloses a system, apparatus, method and computer program for distributing information, comprising

- a. Storing, selecting, and retrieving purchase information (shopping cart) pertaining to a purchase by a user (col 3, lines 4-11);
- b. Receiving and displaying the selected purchase information at a user terminal (col 4, line 56 – col 5, line 19); and
- c. Storing a use log of the user's interaction with the selected purchase information, such as selecting a settlement program (payment method)(Figure 10, item 124; col 3, lines 26-29; col 4, line 56 – col 5, line 19; and col 11, line 32 – col 12, line 9).

While Henson discloses that the information displayed to the user could include "customer-specific merchandising messaging 100 as to up-sell and cross-sell opportunities" (col 9, lines 41-44), it is not explicitly disclosed that the displayed message is a coupon. However, Burke discloses a similar system, apparatus, method, and computer program for distributing information using purchase information which also discloses the promotional message including "games or coupons" (Figure 1, item 57 and col 12, lines 16-20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include coupons as one type of merchandising message in Henson. One would have been motivated to include coupons in order to better motivate the user to purchase the product or service.

Claim 3: Henson and Burke disclose a system for distributing information as in Claim 2 above, and Burke further discloses displaying a coupon to the user. While it is not explicitly disclosed what information is being included on the coupon, the claimed

information (identifier, commodity name, privilege (i.e. discount), store name, and classification name) are common information usually found on coupons. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least the claimed information on the coupon. One would have been motivated to include such information in order to more easily identify and track the usage of the coupon and to better inform the user of the terms of the coupon (i.e. where, when, and for how much the coupon could be used).

Claim 4: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses displaying coupons usable at stores local to the user's present location(col 6, lines 50-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display information, such as a coupon, to the user based on the user's present location. One would have been motivated to use the user's present location when selecting the information to be displayed in order to present information more pertinent to the user.

Claim 5: Henson and Burke disclose a system for distributing information as in Claim 1, but do not disclose the specific information being stored in the use log. The Examiner notes that the claimed information: purchase identifier, user identifier, store identifier, and use date, are the normal type of information stored when tracking usage of coupons and it would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store at least these types of information in Henson. One would have been motivated to store the usage data to include the identifiers of all parties involved and the date of usage in order to allow the coupon

issuer to make a more meaningful analysis of their promotional program as is common in the marketing arts.

Claim 6: Henson and Burke disclose a system for distributing information as in Claim 1 above, and both references further disclose transmitting and storing purchase information (Henson, col 9, lines 26-55)(Burke, col 6, lines 50-61).

Claim 7: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Henson further discloses selecting the information based on matching criteria with the purchase information (col 9, lines 56-67).

Claim 8: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses transmitting the coupon information to the sales terminal (col 6, lines 50-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to not only display the coupon information to the user, but to also transmit the coupon information to the merchant (sales apparatus) for whom the coupon pertains (is redeemable at). One would have been motivated to send this information to the merchant in order for the merchant to be able to verify that the coupon presented by the user is an authorized (authentic) coupon, i.e. cross-checking).

Claims 16-19: Henson and Burke disclose a system for distributing information as in Claim 1 above. While neither reference explicitly discloses that the purchase information pertains to a travel itinerary used to purchase transportation tickets or to an electronic trading system used to purchase shares of stock, the Examiner notes that the type of product or service being purchased by the user does not affect the claimed

steps of using the purchase information to display messages to the user and is, therefore, given little if any patentable weight. It would have been obvious to one having ordinary skill in the art that the system and method described in Henson and claimed in the present invention could be used with purchase information from any type of product or service transaction. One would have been motivated to extend the use to travel and stock purchases in order to increase the utility of the system.

While neither reference explicitly discloses that the user is using a "vending machine", Henson discloses that the user may "access the online store 10 using any suitable computer equipment 40, via the Internet 42" (col 5, line 66 – col 6, line 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user in Henson to access the system via a vending machine, a kiosk, or any other computing device that has access to the Internet. One would have been motivated to allow the user to connect to the system via a vending machine or kiosk in order to allow use of the system when the user is not at home, e.g. in a mall or on vacation.

Claims 9 and 20: Henson and Burke disclose a system for distributing information as in Claims 1 and 19 above, and Henson further discloses issuing a proof of purchase (e.g. a receipt) via at least the Internet (col 9, lines 40-44).

Claim 10: Henson and Burke disclose a system for distributing information as in Claim 9 above. While the type of information of word of mouth (verbally transmitted) is not disclosed, as noted in the 35 U.S.C. 112 rejection above, the contents of a verbal communication is not patentable. Therefore, it would have been obvious to one having

ordinary skill in the art of speaking that any information to include the claimed identifier, store name, and classification, could be verbally communicated to the user in Henson. One would have been motivated to communicate this type of information to the user in order to inform the user about where a particular purchase was made and for what type of product or service.

Claims 21 and 22: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Henson further discloses receiving user feedback (selections) and analyzing such feedback to select information to provide to the user, e.g. recommendations for additional equipment or on the compatibility of the selected equipment. (col 7, lines 29-38).

Claim 23: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke discloses tracking the use of the system to include the merchandising information (e.g. coupons) displayed to the user. While neither reference explicitly discloses that the coupon issuer (advertiser) is charged for the distribution of their information to the user, Official Notice is taken that it is old and well known throughout the marketing arts for advertisers to pay a third party, such as the system in Henson, to display their promotional information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to charge the store (advertiser) for displaying the information to the user in Henson. One would have been motivated to charge the store in order to maintain financial viability of the system.

8. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Burke (5,848,399) as applied to claim 1 above, and further in view of Storey (5,774,870).

Claim 11: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses that the information could be promotional information pertaining to games or coupons (col 12, lines 16-20). However, neither reference explicitly discloses that the user will be awarded prize points for the purchase information, i.e. that is system is part of a merchant's frequent buyer program.

However, Storey discloses a similar system for distributing information in which the user may earn prize points for purchases (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award points to users in Henson. One would have been motivated to award points to the user in order to entice the use to increase participation/utilization of the system.

Claim 12: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 11 above, and Storey further discloses the prize information containing at least the commodity name, a number of points, a number of necessary points, and a classification name (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the prize information in Henson. One would have been motivated

to include this data in order to allow the merchant to better track the promotional program and the number of points outstanding by each user.

Claim 13: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points as in Claim 12 above, and Storey further discloses awarding the prize to the user if the number of points exceeds the number of points necessary for the prize (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award the prize to the user in Henson once the required number of points had been earned. One would have been motivated to award the prize in this manner in order to entice the user to earn more points.

Claim 14: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 1 (and 14) above, and Storey further discloses registering the user (setting up an award point account for the user) and tracking the frequency of use of the system by the user, which is then used to award points (col 1, line 57 – col 2, line 27 and col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to register the user and to award points based on the frequency of access by the user. One would have been motivated to register the user in order to better track the users of the system. One would have been motivated to award points based on the usage of the system in order to entice the user to utilize the system more frequently.

Claim 15: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points as in Claim 14 above, and Storey further

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discloses updating the prize points database each time the user earns or redeems points (col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the user's points account. One would have been motivated to update the points account in order to enable the award system to function.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Blinn et al (5,897,622) discloses a system, method, and apparatus for distributing purchase information to a user to include merchandising information, such as coupons.

b. Fano (6,317,718) discloses a system, method, and apparatus for distributing purchase information to a user based on the location of the user device, such as a PDA, cell phone, laptop, etc.

c. Gershman et al (6,356,905) discloses a system, method, and apparatus for distributing purchase information to a user of a wireless device, such as a PDA, cell phone, laptop, etc.

d. Hager et al (US 2001/0051901) discloses a system, method, and apparatus for distributing purchase information to a user to include merchandising information, such as coupons.



e. Miller et al (US 2001/0054008) discloses a system, method, and apparatus for distributing purchase information to a user based on the products selected by the user.

f. Walker et al (US 2002/0178071) discloses a system, method, and apparatus for distributing purchase information to a user based on the products selected by the user.

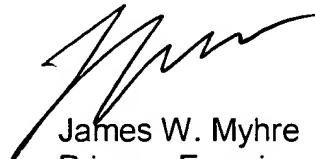
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
June 22, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622